

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LIAO, Heng; NICHOLS, Stacy; LITTLE, Vernon, R.; HUSCROFT, Kevin
Serial No.: 10/771,268
Filed: February 3, 2004
Title: METHOD AND APPARATUS FOR PACKET GROOMING AND AGGREGATION
Group: 2616
Examiner: TRAN, Tung Q
Attorney Ref.: PAT 2241-2 US

May 5, 2008

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
United States Patent and Trademark Office
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U.S.A.

PETITION UNDER 37 CFR 1.81(a)(1) TO WITHDRAW FINALITY OF ACTION AND ENTER AMENDMENTS

Applicants hereby petition under 37 CFR 1.81(a)(1) to withdraw the Final Action dated January 2, 2008 and to request the entry of amendments made under 37 CFR 1.111 submitted on October 15, 2007.

1. STATEMENT OF FACTS

- 1.1. Applicants submitted, in response to the First Action dated July 13, 2007, amendments to claims and arguments in support of patentability of the amended claims, under 37 CFR 1.111 on October 15, 2007. Applicant added new claims 14 and 15. The amendment dated October 15, 2007, is attached in support of this petition (Exhibit A).
- 1.2. The Examiner, in the Final Action dated January 2, 2008, rejected the amendments under 35 USC 112 First Paragraph, and refused to enter the amendments to claims 1, 2, 4, 9 to 11, 13, and new claims 14 and 15 on the basis that the amendment introduced subject matter not disclosed in the application as originally filed.
- 1.3. Applicants requested reconsideration of the finality of the Action in the response filed on March 3, 2008, on the basis that the amended claims were

fully supported in the application as originally filed, and showed detailed support in the application. The amendment dated March 3, 2008, is attached in support of this petition (Exhibit B).

- 1.4. The response to the Final Action was filed within the two-month time period following the Final Action.
- 1.5. The Examiner, in an Advisory Action dated April 4, 2008, maintained his refusal to enter the amendments to claims 1, 2, 4, 9 to 11, 13, and new claims 14 and 15, without further reasons.
- 1.6. In a telephone interview on April 24, 2008, the Examiner and Applicant's representative discussed the rejections under 35 USC 112 First Paragraph. Applicant's representative demonstrated that the limitations to claims 1, 4, and 9 were fully supported in the specification as originally filed. The Interview Summary prepared by the Examiner, dated April 29, 2008, is attached in support of this petition (Exhibit C).

2. CONCLUSION

- 2.1. Applicants submit that a timely response to the Action of July 13, 2007 was filed on October 15, 2007. In accordance with 37 CFR 1.181(c), a proper request for reconsideration of the finality of the Action issued on January 2, 2008 was made on March 3, 2008. In the Advisory Action dated April 4, 2008, the Examiner repeated his refusal to enter the amendments without further reasons.
- 2.2. Applicants submit that the amendments submitted on October 15, 2007, were fully supported by the specification as originally filed, as acknowledged by the Examiner and should have been entered and considered by the Examiner.
- 2.3. The Examiner's rejections under 35 USC 112 First Paragraph were improper, the amendments were fully supported by the specification as originally filed, and failure to enter the amendments prematurely cut off the prosecution of this application.
- 2.4. Applicants submit that, in accordance with 37 CFR 1.111, the reply filed on October 15, 2007, was entitled to further examination. The reply by the Applicants presented arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. Applicant's reply was a *bona fide* attempt to advance

the application for allowance. The Examiner's subsequent action was neither the result of reconsideration or further examination, thereby unfairly prejudicing the Applicants.

- 2.5. The Examiner failed to address the Applicants request for reconsideration or failed to properly reconsider the finality of the Action issued on January 2, 2008, as requested by the Applicants in their response dated March 3, 2008.
- 2.6. Based on the facts of this case, Applicants believe that the Final Action dated January 2, 2008 is premature and that it is reviewable by petition under 37 CFR 1.181. Therefore, Applicants respectfully request the withdrawal of Final Action dated January 2, 2008 and entry of amendments made under 37 CFR 1.111 submitted on October 15, 2007.

3. FEES

- 3.1. The petition fee in the amount of \$130.00 is submitted herewith. A petition for a one-month extension of time is being made under separate cover. The Commissioner is hereby authorized to charge any additional fees, and credit any overpayments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,

LIAO, Heng et al

By: /Anne Kinsman/
Anne Kinsman
Reg. No. 45,291
Borden Ladner Gervais LLP
World Exchange Plaza
100 Queen Street, Suite 1100
Ottawa, ON K1P 1J9
CANADA
Tel: (613) 237-5160
Fax: (613) 787-3558
E-mail: ipinfo@blgcanada.com

ALK/MC/dbm

Encls.

1. Exhibit A, B and C